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No. 71-967

In the
Supreme Court of the United States
OCTOBER TERM, 1971

EUGENE A. WAHL and
VIBRA SCREW FEEDERS, INC.,
Petitioners,

vs.

CARRIER MANUFACTURING CO., INC.,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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1. Findings of the Trial Court and the Appellate Court

This is a run-of-the mill patent infringement case. Petitioners charged Respondent with infringement of patent No. 3,173,583 for a "bin activator". After the usual discovery proceedings, the case came on for trial before Judge Steckler in the United States District Court in Indianapolis. As stated by the 7th Circuit Court of Appeals (Appendix 12a),* the trial court heard voluminous testimony in a trial which lasted eight days. The testimony principally involved the testimony of Wahl and Fischer

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* Reference in this brief will be made to the Opinion of the 7th Circuit Court of Appeals and to the Findings of Fact and Conclusions of Law as they appear in the Appendix to the Petition for the Writ of Certiorari.

in their capacity as experts testifying in great detail in explanation of many physical exhibits, the prior art cited by the Patent Office, and that not cited by the Patent Office but relied upon by defendant. As indicated in the Opinion of the Court of Appeals (Appendix 8a), the trial court was called upon to consider the testimony of the two principal witnesses, Wahl and Fischer, and it appears that the District Court rejected the testimony of Wahl and credited the testimony of Fischer.

Before the Court of Appeals, Petitioners urged that the trial court did not understand the concept of the Wahl invention and that the court was misled by Respondent's expert, Fischer. Relative to his assertion by Petitioners, the Court of Appeals stated:

> "The record refutes the suggestion that Judge Steckler was led astray. It reveals that he was keenly aware of the issues for decision and the contentions of the respective parties, and actively participated in the examination of the expert witnesses. * * *" (Appendix 9a)

The court entered Findings and Conclusions of Law which although prepared by counsel for Respondent, was substantially modified to conform with the court's suggestions. These Findings of Fact with respect to the validity and infringement of the patent here in suit were affirmed by the Court of Appeals.

An examination of the Findings of Fact of the trial court discloses that the court (Appendix 33a) described the device disclosed in the patent in suit, referred to the claims thereof and considered what is alleged to be the invention disclosed by these claims (Appendix 33a-35a). The trial court then considered one of the prior use devices asserted by defendant to be an anticipation of the patent in suit (Ap-

pendix 35a-38a) described the structure of the device, how the structure was related to the elements set forth in the claims of the patent in suit, referred to the fact that this prior art device made and sold by Petitioners was not called to the attention of the Patent Office, and concluded that this heavy duty feeder made and sold by Petitioners comes within the claims of the patent in suit and it therefore anticipated. The trial court also found that if the Patent Office was aware of the existence of this heavy duty feeder as a prior art device, the Patent Office would not have granted any claims in the application for the patent in suit (Appendix 37a-38a).

In the same manner the court considered the non-cited Carrier patent No. 3,187,884 and Respondent's commercial product of the structure shown generally in this patent both of which constituted prior art to the patent in suit, and concluded that the Carrier patent and the prior art device made in accordance therewith anticipated the claims of the patent here in suit (Appendix 38a-39a).

The trial court in its findings considered the Musschoot patent No. 3,083,811, and described what is shown in that patent and concluded that all of the elements of the claims of the patent here in suit could be found in the Musschoot patent, functioning in the same way to produce substantially the same result as that produced by the structure of the patent in suit, and found that the Musschoot patent constituted an anticipation of the claims of the patent in suit (Appendix 40a).

In the Findings of Fact of the Trial Court (Appendix 43a-44a) the court determined the scope and content of the prior art, the level of the ordinary skill in the pertinent art, and concluded that at the time the asserted invention

was made, the subject matter thereof would have been obvious to a person of ordinary skill in the art.

From a reading of these findings of the trial court it is apparent that the trial court found that the invention claimed in the claims of the patent in suit was anticipated by the Wahl heavy duty feeder made and sold by Petitioners, was anticipated by Carrier patent No 3,187,884 and by the commercial embodiment of that device made and sold by Respondent, that the claims of the patent in suit were anticipated by Musschoot patent No. 3,083,811, and that to the extent there are any differences between the subject matter of the claims and these prior art devices and patents, the subject matter claimed in the patent in suit would have been obvious at the time the invention was made to a person having ordinary skill in the art. The finding of invalidity of the claims of the patent in suit was therefore predicated upon both anticipation under Title 35 U.S.C. Sec. 102 and upon obviousness under Title 35 U.S.C. Sec. 103.

The trial court, notwithstanding its finding of invalidity of the patent in suit, considered the question of Respondent's infringement of the claims and based upon a resolution of conflict of testimony before it, concluded that because of file wrapper estoppel during the prosecution of the patent in suit, the claims should be limited in a manner such that many of the devices charged to infringe actually did not infringe, but held that certain of the devices would infringe the claims of the patent in suit if these claims were valid (Appendix 44a-48a).

All of these matter were given adequate consideration by the Court of Appeals in its opinion, and the court affirmed the decision and judgment of the trial court with respect to anticipation, obviousness and infringement.

2. There is No Reason For the Grant of Certiorari In This Case

Rule 19 of the Rules of the Court sets forth generally the reasons for which this court may grant certiorari. With respect to Rule 19-1, it is not applicable here since there is no State Court decision involved and there is not even any attempt to show herein that the decision of the Court of Appeals in this case has decided an important question in a way in conflict with the applicable decision of this court. Certainly there is no conflict of decisions of different Courts of Appeals with respect to the validity of the patent in suit. There is therefore no showing under Rule 19 that certiorari should be granted in this case.

In the Petition for the writ, Petitioners assert that the trial court and the Court of Appeals interpreted the claims of the patent in one way for purposes of novelty, and another way for purposes of infringement. Throughout the course of the trial at the trial court level, and in the Court of Appeals, Petitioners consistently urged that for purposes of avoiding the prior art, the claims should be very narrowly construed, but for purposes of infringement to cover all of the varying devices made by Petitioners, the claims were entitled to a very board interpretation. This was referred to in Finding 14 (Appendix 42a) wherein it stated:

> "For purposes of avoiding the prior art, Wahl very narrowly construed what he considered to be his invention by placing the material-agitating means and the material-receiving means in a specific location, referred to by him as the compaction zone, but for purposes of infringement and attempting to read the claims upon certain of defendant's devices, he ignored these specific limitations and gave to the claims a much broader interpretation."

It thus appears that reason No. 1 (Petition, Page 10) asserted for granting the writ was completely and adequately resolved by the trial court based upon a conflict of testimony as to the scope of the claims in the light of the prior art presented.

The Court of Appeals stated:

> "Thus, the trial court was confronted with the testimony of two knowledgeable witnesses who in some respects were in wide disagreement as to what Wahl had invented, as disclosed by his patent, and the disclosure of the prior art. It was that court's function, not ours on review, to weigh the conflicting testimony and judge of the credit to be given the witnesses. We are satisfied that the court properly performed its duty in this respect. Certainly we cannot hold that the finding was clearly erroneous under Rule 52(a)." (Appendix 16a).

It is thus abundantly clear that reason No. 1 asserted in the Petition for granting the writ involves only a determination by the trial court and the Court of Appeals based upon a resolution of conflicting testimony.

On page 13 of the Petition, as reason No. 2 for the grant of the writ, it is asserted that the decisions of the courts below are in conflict with the decision of this Court as to the manner of determining obviousness under Sec. 103 of the patent statutes. Petitioners assert that the District Court did not make note of the differences between the patent claims and the prior art and then determine the obviousness of the advance made by the patentee. This assertion by Petitioners completely ignores the fact that in the opinion of the trial court there are specific findings holding the claims of the Wahl patent to be anticipated by the Wahl heavy duty feeder, the Carrier patent and

the commercial embodiment of the Carrier patent and by the Musschoot patent. In the Petition there is no attack upon these findings of anticipation, and this being so, there was really no reason why the court should get to a resolution of the question of obviousness under Sec. 103 of the patent statutes. Nevertheless, the court did so, and carefully following the mandate of this Court in *Graham* v. *John Deere* (383 U.S. 1), determined the facts with respect to each of the prior art devices and patents relied upon (Appendix 36a-42a), determined the scope and content of the prior art (Appendix 43a), determined the level of the ordinary skill in the pertinent art (Appendix 43a), and stated in Conclusion of Law 5 (Appendix 48a) that notwithstanding the holding of anticipation on the question of obviousness under Title 35 U.S.C. Sec. 103, the conclusion is reached:

> ". . . that the differences between the subject matter sought to be patented in the Wahl patent and the prior art referred to above are such that subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains."

In the Petition (Page 13) there is a statement that the actual basis for the conclusion of obviousness is drawn from a finding by the trial court that an employee of Respondent arrived at the same solution independently. This the trial court did, but this reason for a holding of obviousness was only in addition to the basic ground of obviousness over the prior art referred to by the trial court. If the trial court had not referred to this additional bit of evidence in establishing obviousness, the basic finding of the court with respect to obviousness would

still stand. The Petition in this aspect presents no reason for the grant of the writ.

As indicated by the Court of Appeals (Appendix 8a), the District Court resolved the problem before it by weighing the testimony of the two experts who testified at length before the trial court and made its determination on the question of validity and infringement. As the Court of Appeals stated (Appendix 12a) the court heard voluminous testimony in a trial which lasted eight days. It thus appears that Petitioners had every opportunity to present their case to the trial court wich after thorough consideration entered judgment against Petitioners. The judgment of the trial court was considered and affirmed by the Court of Appeals in a lengthy opinion which discussed all of the arguments advanced by Petitioners.

What the Petitioners would really like to have this Court do is to grant the writ and consider de novo all of the facts presented to the trial court with the hope that this court would reach a different conclusion upon an analysis of these facts.

There is no valid reason asserted in the Petition for this Court to grant a writ of certiorari in this case, and it is submitted that the Petition should be denied.

Respectfully submitted,

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In the appendix to the Petition herein Conclusions of Law 8 and 9 are set forth at pages 49a and 50a. These relate to fraud on the Patent Office and the allowance to defendant of attorney's fees in this case. This is the original form of Judgment entered by the trial court on November 5, 1969, but attention is called to the joint appendix filed in the Court of Appeals, page 31a, wherein an order was entered amending the courts conclusions of law and wherein paragraph 9 was stricken and paragraph 8 modified to exclude a finding of fraud on the Patent Office.